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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,603	02/19/2004	Robert E. Grove	2502187-991200	1625

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LAW OFFICES OF JAMES E. EAKIN
P.O. Box 1250
Menlo Park, CA 94025

EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3735

MAIL DATE	DELIVERY MODE
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10/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/783,603	Applicant(s) GROVE ET AL.	
	Examiner david shay	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 19, 2007
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 79-114 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 79-114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant argues that Slatkine ('633) "reflects a fundamental misunderstanding of what is required to make a laser eye safe" and has submitted two Declarations (the Declaration of Joseph W. Goodman, hereinafter the "Goodman Declaration" and the Declaration of Gary C. Bjorklund, hereinafter the "Bjorklund Declaration") to bolster this assertion. Applicant mentions in particular the passage at page 7, lines 7-18 of the Slatkine ('633) reference (hereinafter, the "Passage"). Applicant points to the last sentence of the Passage, which states that "When the divergent half angle is 60 degrees, no protective eye glasses are required". Applicant points out that both the aforementioned Declarations state that diverging a laser beam at a half angle of 60 degrees, does not make it eye safe. Applicant goes on to assert that "if one of ordinary skill in the art were to build a device compliant with the examples shown in the '633 by using a low angle diffuser and diverging lens as taught there, the resulting device would potentially blind both eyes of an observer or an operator or a patient" and concludes that the device of Slatkine ('633) is more dangerous than a device without the diffusing unit taught therein.

Applicant then points out that the Bjorklund Declaration analyzes all the various examples of diffusing devices taught by Slatkine ('633) and finds that none of them are eye safe. Applicant also notes that "both Prof. Goodman and Dr. Bjorklund conclude that the '633 provides no guidance which would enable one of ordinary skill in the art to balance the conflicting objectives of achieving an optical output which is eye safe, while at the same time being of sufficient fluence to effect hair removal on a human, and also has an optical diffuser for diffusing the light so that the light emitted from the apparatus is eye safe."

The examiner will now analyze the Bjorklund Declaration. The Bjorklund Declaration establishes the credentials of Declarant in the first paragraph. The second paragraph avers that

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Declarant has no relationship, nor financial interest in the outcome of this matter, nor the assignee. In paragraph 3, Declarant recites the standard for eye safe radiation discussed in Slatkine ('633), and in paragraph 4, while acknowledging that the statement is correct notes that the attribution for the source thereof is erroneous. At paragraph 5, Declarant, states that the disclosure of Slatkine ('633) would not be eye safe, but dangerous, and at paragraph 6, reproduces the Passage, and states that except for very low power lasers, which "would not be effective to remove hair" diverging by a half angle of 60 degrees would not render the beam eye safe. With regard to these statements, the examiner must note that neither the instant claims nor the Slatkine ('633) are so limited. Instant claim 94 refers only to "dermatologic treatment", while the Slatkine ('633) disclosure encompasses a whole host of "aesthetic" treatments (see page 11, lines 6-12 of Slatkine ('633)). Thus these evaluations of the teachings of Slatkine ('633) are erroneous. In paragraph 7, Declarant points to another passage concerning Figure 14, again stating that the light cannot be rendered eye safe with the arrangement therein. It is not clear that Declarant reviewed the actual figure this passage describes, however. The embodiment depicted clearly shows a stand off that allows the laser radiation to propagate until its cross section has increased to the point where the energy is at an eye safe level. The basis of Declarant's assertion that having an eye safe level is not possible, while having no idea whatsoever as to the cross section contemplated by Slatkine ('633), is far from clear, and thus the statements are not convincing. The discussion of Figure 14a at paragraph 8 suffers similar deficiencies. In paragraphs 9 and 10, Declarant discusses the diffusers of Figure 8b, however, Declarant does not discuss how the extended sources will be reimaged on the retina, given that the initial diffuser is composed of lenslets which "have a very short focal length of

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approximately a few wavelengths" (see page 32, lines 14-17). Thus these statements are not convincing. In view of the deficiencies of the statements enumerated above, the subsequent opinions set forth in paragraphs 11 through 17, which are predicated on the correctness of the statements preceding them, are not convincing. Similarly, the tables of results, which do not detail the precise types of diffusers, or, when detailed, make no effort to modify the designs to produce eye safe radiation, are not convincing of the lack of such teachings in Slatkine ('633).

The examiner will now analyze the Goodman Declaration. The Goodman Declaration establishes the credentials of Declarant in the first paragraph. The second paragraph avers that Declarant has no relationship, nor financial interest in the outcome of this matter, nor the assignee. In paragraph 3, Declarant states that the claims of eye safe radiation in Slatkine ('633) are misleading. At paragraph 4, Declarant reproduces the Passage, and states that simple divergence except for very low power lasers, diverging by a half angle of 60 degrees would not render the beam eye safe, the beam must be made spatially incoherent. In paragraphs 5 and 6, Declarant points to another passage concerning Figure 14, again stating that the light cannot be rendered eye safe with the arrangement therein. It is not clear that Declarant reviewed the actual figure this passage describes, however. The embodiment depicted clearly shows a stand off that allows the laser radiation to propagate until its cross section has increased to the point where the energy is at an eye safe level additionally, the wavelengths used for this embodiment are not transmitted to the retina (see paragraph 7 of the Declaration by Rolland G. Wheeland, MD), thus rendering imaging thereof on the retina highly unlikely. The basis of Declarant's assertion that having an eye safe level is not possible, while having no idea whatsoever as to the cross section contemplated by Slatkine ('633), is far from clear, and thus the statements are not convincing.

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The discussion of Figure 14a at paragraph 5 suffers these deficiencies. In paragraph 7, Declarant discusses the diffusers of Figure 8b, however, Declarant does not discuss how the extended sources will be reimaged on the retina, given that the initial diffuser is composed of lenslets which "have a very short focal length of approximately a few wavelengths" (see page 32, lines 14-17). Clearly the "random distribution of craters of different size" produced by the process which is essentially sand blasting a transparent plate (see page 32 of Slatkine ('633)) will yield a diffuser which renders the output beam spatially incoherent. Thus these statements are not convincing. In view of the deficiencies of the statements enumerated above, the subsequent opinions set forth in paragraphs 8 through 13, which are predicated on the correctness of the statements preceding them, are not convincing. Similarly, the tables of results, which do not detail the precise types of diffusers, or, when detailed, make no effort to modify the designs to produce eye safe radiation, are not convincing of the lack of such teachings in Slatkine ('633).

It is interesting to note, that nowhere in the originally filed disclosure is there any discussion of exactly how the claimed diffuser is made, it is merely stated that it can be made from various commercially available stock materials such as opalized glass, and tetrapolyflouroethylene (PTFE). Thus it is unclear, if the disclosure of Slatkine ('633) is not enabling, how the instant disclosure would be considered otherwise.

With regard to the remaining two Declarations (the Declaration of Rolland G. Wheeland, MD, hereinafter the "Wheeland Declaration" and the Declaration of Suzanne Kilmer, MD, hereinafter the "Kilmer Declaration"), applicant asserts that the Declarants were "astounded" and "amazed" that such a device was possible. The examiner has reviewed these Declarations. From the statements therein, there can be little doubt that both Declarants are very experienced in the

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use of hair removal lasers. However, the instant claims are drawn to a device, not a method, and as such, one of ordinary skill in the art is more properly one who designs and builds depilation lasers, rather than those who use them. For example, the examiner has had many, many years experience driving a wide variety of cars. However, this does not mean that the examiner is aware of teachings which are old and well known in, for example, the transmission art. Thus the surprise with which a user of a device may view a certain feature, does not necessarily render that feature surprising to those who build the devices. Thus these arguments are not convincing.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 80 and 96 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 80, it is unclear what further limitation is intended to be implied by reciting the duration of the resultant hair removal. Claim 96 is indefinite because it is unclear how the device can be configured so that "the diffuser is larger in area than the input" when claim 94, from which claim 96 depends, requires that the light be distributed "uniformly across the input of the diffuser". This claim is too indefinite to apply art to.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 79-85, 88, 90-95, 97, 98, 101-103, and 105-114 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Slatkine (WO '633).

See generally the entire document, and especially Figures 4a-d, 5d, 6a, 6bg, 7a-c, 8a, 8b, 9a, 9b, 10a, 10b, 1112a, 12b, 13, 14a, 14b, 15e, 15f, 16, 17a and pages 4, 9-11, 14-16, 22-32, and 41-44.

Claims 87 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slatkine (WO '633) in combination with Connors et al. Slatkine (WO '633) teach a device such as claimed, as set forth above, but does not disclose the device as including a flashlamp per se. Connors et al teach the desirability of using a flash lamp pumped Nd:YAG laser for hair removal. It would have been obvious to the artisan of ordinary skill to employ a flash lamp pumped Nd:YAG laser in the device of flash lamp pumped Nd:YAG laser since this is appropriate for hair removal, as taught by Connors et al, and emits within the preferred range of Slatkine (WO '633), thus producing device such as claimed.

Claims 86, 89, 99, and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slatkine (WO '633) in combination with Grove et al ('901). Slatkine (WO '633) teach a device such as claimed, as set forth above, but does not disclose the device as including a diode bar per se. Grove et al ('901) teach the desirability of using diode bars in a dermatological device. It would have been obvious to the artisan of ordinary skill to employ the diode bars of Grove et al ('901) in the device of Slatkine (WO '633) since this provides high intensity light, thus producing device such as claimed.

Applicant's arguments filed July 19, 2007 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

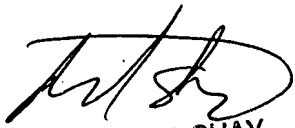
Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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